



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,044	06/28/2001	Martin C. Boire	BOI-ICIP	6168
23717	7590	07/06/2005	EXAMINER	
LAW OFFICES OF BRIAN S STEINBERGER 101 BREVARD AVENUE COCOA, FL 32922			MILLER, WILLIAM L	
			ART UNIT	PAPER NUMBER

3677

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/894,044

Applicant(s)

BOIRE ET AL.

Examiner

William L. Miller

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-32 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) is/are allowed.
- 6) ☒ Claim(s) 33,35,36 is/are rejected.
- 7) ☐ Claim(s) is/are objected to.
- 8) ☐ Claim(s) are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

5-0-0

DETAILED ACTION

Response to Amendment

1. The reply received 04-25-2005 has been entered. Claims 1-36 are pending.

Election/Restrictions

2. Claims 1-32 and 34 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic claim.

Claim Rejections - 35 USC § 112

3. Claims 33, 35, and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original disclosure fails to provide support for the new claimed gap range of greater than 50° and less than 180°.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 33, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grainger General Catalog (hereinafter "Grainger").
6. Grainger discloses on page 373 a device designated "C" to be applied to a conduit (electrical cable), comprising: a plate that includes a flat surface; and an integral saddle fitting

having a gap measuring between 45 and 50 degrees according to the applicant (see response dated 06-23-04, page 8, last paragraph). The device is being viewed as a "labeling device" and the flat surfaced plate is being viewed as a "sign plate" as the applicant is not claiming any signage, indicia, markings, etc. The applicant is reminded where there is physical identity between the subject matter of the claims and the prior art, the label given to the claimed subject matter does not distinguish the invention over the prior art. In re Pearson, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974); In re Lemin, 326 F.2d 437, 140 USPQ 273 (CCPA 1964).

7. Regarding claims 33 and 36, Grainger discloses the gap measures between 45 and 50 degrees as opposed to greater than 50 degrees and less than 180 degrees as now claimed by the applicant. However, the specific gap angle is not a critical feature of the invention, as page 6, line 16, of the instant specification only requires the gap to be less than 180 degrees, a requirement thus met by Grainger. Further, the examiner notes this is the only statement in the entire specification regarding the gap's angular dimension. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Grainger device by utilizing a gap in the range of greater than 50 degrees and less than 180 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

8. Alternatively, claims 33, 35, and 36 are rejected under 35 U.S.C. 103(a) as being Grainger in view of Piana (US#4268986).

9. Regarding claims 33 and 36, if the gap angle is not viewed as obvious per lack of criticality and *In re Aller*, Piana discloses a similar device wherein a saddle fitting 1 gap is clearly shown in Fig. 2, and measures, greater than 50 degrees and less than 180 degrees to accommodate a corresponding sized element. Therefore, as taught by Piana, it would have been obvious to one of ordinary skill in the art at time the invention was made to modify the Grainger device by utilizing a gap in the range of greater than 50 degrees and less than 180 degrees in order to accommodate a corresponding sized conduit.

Response to Arguments

10. Regarding the 35 U.S.C. 112, first paragraph, rejection, the applicant argues the now claimed feature of the gap measuring between greater than 50° and less than 180° does not constitute new matter as page 6, line 16 of the instant specification recites the gap is less than 180°. The examiner disagrees as the claimed range further limits the range disclosed in the specification. Moreover, the original disclosure does not provide support for the exclusion of a gap measuring 50° or less.

11. Regarding claims 33 and 36, the examiner agrees the now claimed gap of greater than 50° and less than 180° obviates the anticipatory rejection of the previous Office action. However, as discussed above, this limitation does not render the claims allowable.

12. The examiner notes the applicant provided no other arguments specific to the remainder of the examiner's analysis of Grainger and therefore has effectively conceded thereto.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

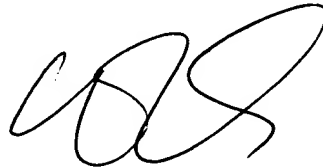
Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Miller whose telephone number is (571) 272-7068. The examiner can normally be reached on Tuesday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3677

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William L. Miller
Primary Examiner
Art Unit 3677

A handwritten signature in black ink, appearing to be 'WLM', written in a cursive style.

WLM